

PTO/SB/05 (08-03)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 C.F.R. 1.53(b))

Attorney Docket No. 38005-0184

First Inventor Gerhard JAEHNE et al.

Title DERIVATIVES OF C2-SUBSTITUTED INDAN-1-OL  
SYSTEMS FOR THE PROPHYLAXIS OR TREATMENT OF  
OBESITY

Express Mail Label No.

## APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

## ADDRESS TO:

Mail Stop Patent Application  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)  
(Submit an original and a duplicate for fee processing)
2. ☐ Applicant claims small entity status.  
See 37 CFR 1.27.
3. ☒ Specification [Total Pages 48]  
(preferred arrangement set forth below)
  - Descriptive title of the Invention
  - Cross Reference to Related Applications
  - Statement Regarding Fed sponsored R & D
  - Reference to sequence listing, a table,  
or a computer program listing appendix
  - Background of the Invention
  - Brief Summary of the Invention
  - Brief Description of the Drawings (if filed)
  - Detailed Description
  - Claim(s)
  - Abstract of the Disclosure
4. ☐ Drawing(s) (35 U.S.C.113) [Total Sheets ]
5. Oath or Declaration [Total Pages 4]
  - a. ☐ Newly executed (original or copy)
  - b. ☒ Copy from a prior application (37 CFR 1.63 (d))  
(for a continuation/divisional with Box 18 completed)
  - i. ☐ DELETION OF INVENTOR(S)  
Signed statement attached deleting inventor(s)  
named in the prior application, see 37 CFR  
1.63(d)(2) and 1.33(b).
6. ☒ Application Data Sheet. See 37 CFR 1.76

7. ☐ CD-ROM or CD-R in duplicate, large table or  
Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission  
(if applicable, all necessary)
  - a. ☐ Computer Readable Form (CRF)
  - b. Specification Sequence Listing on:
    - i. ☐ CD-ROM or CD-R (2 copies); or
    - ii. ☐ paper
  - c. ☐ Statements verifying identity of above copies

## ACCOMPANYING APPLICATIONS PARTS

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 C.F.R. §3.73(b) Statement ☐ Power of  
(when there is an assignee) Attorney
11. ☐ English Translation Document (if applicable)
12. ☒ Information Disclosure ☐ Copies of IDS  
Statement (IDS)/PTO-1449 Citations
13. ☒ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503)  
(Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s)  
(if foreign priority is claimed)
16. ☐ Nonpublication Request under 35 U.S.C. 122  
(b)(2)(B)(i). Applicant must attach form PTO/SB/35  
or its equivalent.
17. ☐ Other: \_\_\_\_\_

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in the first sentence of the specification following the title, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☒ Divisional ☐ Continuation-in-part (CIP)

of prior application No: 10 / 230,379

Prior application information: Examiner J. F. Vollano

Group / Art Unit: 1621

For CONTINUATION or DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

## 19. CORRESPONDENCE ADDRESS

☒ Customer Number:

26633

or ☐ Correspondence address below

Name Heller Ehrman White & McAuliffe LLP

Address

City

State

Zip Code

Country

Telephone

Fax

Name (Print/Type)

Patricia D. Granados

Registration No. (Attorney/Agent)

33,683

Signature

Patricia D. Granados

Date

October 27, 2003

This collection of information is required by 37 CFR 1.53(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**FEE TRANSMITTAL  
for FY 2003**

Effective 01/01/2003. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** (\$) 770.00**Complete if Known**

|                      |                            |
|----------------------|----------------------------|
| Application Number   | Divisional of 10/230,379   |
| Filing Date          | October 27, 2003           |
| First Named Inventor | Gerhard JAEHNE et al.      |
| Examiner Name        | J.F. Vollano (parent case) |
| Art Unit             | 1621 (parent case)         |
| Attorney Docket No.  | 38005-0184                 |

**METHOD OF PAYMENT (check one)**
☒ Check    ☐ Credit card    ☐ Money Order    ☐ Other    ☐ None
☒ Deposit Account:Deposit  
Account  
Number

08-1641 (Docket No. 38005-0184)

Deposit  
Account  
Name

Heller Ehrman White &amp; McAuliffe LLP

The Commissioner is authorized to: (check all that apply)

- ☐ Charge fee(s) indicated below    ☐ Credit any overpayments
- ☒ Charge any additional fee(s) during the pendency of this application
- ☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

**FEE CALCULATION****1. BASIC FILING FEE**

| Large Fee Code | Entity Fee (\$) | Small Fee Code | Entity Fee (\$) | Fee Description        | Fee Paid |
|----------------|-----------------|----------------|-----------------|------------------------|----------|
| 1001           | 770             | 2001           | 385             | Utility filing fee     | 770      |
| 1002           | 330             | 2002           | 165             | Design filing fee      |          |
| 1003           | 520             | 2003           | 260             | Plant filing fee       |          |
| 1004           | 750             | 2004           | 375             | Reissue filing fee     |          |
| 1005           | 160             | 2005           | 80              | Provisional filing fee |          |

SUBTOTAL (1) (\$)

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

| Total Claims       | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------|----------------|----------|
| 10                 | -20** = 0    | 18             | 0.00     |
| 1                  | -3** = 0     | 86             | 0.00     |
| Multiple Dependent |              |                |          |

| Large Fee Code | Entity Fee (\$) | Small Fee Code | Entity Fee (\$) | Fee Description   |
|----------------|-----------------|----------------|-----------------|---|
| 1202           | 18              | 2202           | 9               | Claims in excess of 20                                    |
| 1201           | 86              | 2201           | 42              | Independent claims in excess of 3                         |
| 1203           | 280             | 2203           | 140             | Multiple dependent claim, if not paid                     |
| 1204           | 84              | 2204           | 42              | **Reissue independent claims over original patent         |
| 1205           | 18              | 2205           | 9               | **Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$)

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

| Large Fee Code | Entity Fee (\$) | Small Fee Code | Entity Fee (\$) | Fee Description  | Fee Paid |
|----------------|-----------------|----------------|-----------------|--|----------|
| 1051           | 130             | 2051           | 65              | Surcharge - late filing fee or oath  |          |
| 1052           | 50              | 2052           | 25              | Surcharge - late provisional filing fee or cover sheet                     |          |
| 1053           | 130             | 1053           | 130             | Non-English specification  |          |
| 1812           | 2,520           | 1812           | 2,520           | For filing a request for <i>ex parte</i> reexamination                     |          |
| 1804           | 920*            | 1804           | 920*            | Requesting publication of SIR prior to Examiner action                     |          |
| 1805           | 1,840*          | 1805           | 1,840*          | Requesting publication of SIR after Examiner action                        |          |
| 1251           | 110             | 2251           | 55              | Extension for reply within first month                                     |          |
| 1252           | 410             | 2252           | 205             | Extension for reply within second month                                    |          |
| 1253           | 930             | 2253           | 465             | Extension for reply within third month                                     |          |
| 1254           | 1,450           | 2254           | 725             | Extension for reply within fourth month                                    |          |
| 1255           | 1,970           | 2255           | 985             | Extension for reply within fifth month                                     |          |
| 1401           | 320             | 2401           | 160             | Notice of Appeal   |          |
| 1402           | 320             | 2402           | 160             | Filing a brief in support of an appeal                                     |          |
| 1403           | 280             | 2403           | 140             | Request for oral hearing   |          |
| 1451           | 1,510           | 1451           | 1,510           | Petition to institute a public use proceeding                              |          |
| 1452           | 110             | 2452           | 55              | Petition to revive - unavoidable   |          |
| 1453           | 1,300           | 2453           | 650             | Petition to revive - unintentional   |          |
| 1501           | 1,300           | 2501           | 650             | Utility issue fee (or reissue)   |          |
| 1502           | 470             | 2502           | 235             | Design issue fee   |          |
| 1503           | 630             | 2503           | 315             | Plant issue fee  |          |
| 1460           | 130             | 1460           | 130             | Petitions to the Commissioner  |          |
| 1807           | 50              | 1807           | 50              | Processing fee under 37 CFR 1.17(q)  |          |
| 1806           | 180             | 1806           | 180             | Submission of Information Disclosure Stmt                                  |          |
| 8021           | 40              | 8021           | 40              | Recording each patent assignment per property (times number of properties) |          |
| 1809           | 750             | 2809           | 375             | Filing a submission after final rejection (37 CFR 1.129(a))                |          |
| 1810           | 750             | 2810           | 375             | For each additional invention to be examined (37 CFR 1.129(b))             |          |
| 1801           | 750             | 2801           | 375             | Request for Continued Examination (RCE)                                    |          |
| 1802           | 900             | 1802           | 900             | Request for expedited examination of a design application                  |          |

Other fee (specify) \_\_\_\_\_

\* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

**SUBMITTED BY**

|                   |                             |                                   |                  |              |                |
|-------------------|-----------------------------|-----------------------------------|------------------|--------------|----------------|
| Name (Print/Type) | Patricia D. Granados        | Registration No. (Attorney/Agent) | 33,683           | Telephone    | (202) 912-2000 |
| Signature         | <i>Patricia D. Granados</i> | Date                              | October 27, 2003 | Customer No. | 26633          |

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.